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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91219703
Party	Defendant Alexso, Inc.
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Attachments	Answer_3M Opposition.pdf(239531 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

3M Company.;

Opposer,

vs.

Alexso, Inc.,

Applicant.

Opposition No. 91219703

Mark: TERODERM and Design

Serial No.: 86/228838

Filing Date: March 21, 2014

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APPLICANT’S ANSWER TO NOTICE OF OPPOSITION

Alexso, Inc., (“Applicant”), a California corporation located at 2317 Cotner Avenue, Los Angeles, CA 90064 respectfully submits the following answer to the Notice of Opposition filed on December 10, 2014 (“Notice of Opposition”) by 3M Company, Inc. (“Opposer”).

1. Applicant acknowledges that it applied to register TERODERM and Design mark (hereinafter the “Mark”) on the Principal Register for “Excipients for use in the manufacture of pharmaceutical preparations,” in International Class 1 and “Sanitary preparations for medical purposes; medical plasters and dressings; disinfectants; fungicides, herbicides; preparations for destroying vermin; lipophilic liposomic cream used as a base in preparations for transdermal delivery of pharmaceutically active ingredients; lipophilic liposomic creams used as a base in preparations for transdermal delivery of pharmaceutically active ingredients sold to

dispensing doctors, independent compounding and non-compounding pharmacists, and retail stores; hydrophilic liposomic cream used as a base in preparations for transdermal delivery of pharmaceutically active ingredients; hydrophilic liposomic creams used as a base in preparations for transdermal delivery of pharmaceutically active ingredients sold to dispensing doctors, independent compounding and non-compounding pharmacists, and retail stores.”

2. Applicant admits these allegations.

3. Applicant is without sufficient information to admit or deny this paragraph and on that basis denies same.

4. Applicant admits that Opposer owns the TEGADERM registrations as set forth in the Opposition.

5. Applicant admits these allegations.

6. Applicant is without sufficient information to admit or deny this paragraph and on that basis denies same.

7. Applicant is without sufficient information to admit or deny this paragraph and on that basis denies same.

8. Applicant is without sufficient information to admit or deny this paragraph and on that basis denies same.

9. Applicant denies that it was aware of Opposer’s use of TEGADERM as a trademark.

10. Applicant denies that its Mark is confusingly similar to Opposer’s TEGADERM mark. “Derm” is an abbreviation of a general and widely used term used in connection with any skin related product or service. A simple word mark search on the United States Patent and Trademark Office’s Trademark Electronic Search System returns Seven Hundred and Eighty

One (781) records incorporating the term “derm.” A significant number of these results are eight (8) letter wordmarks ending in “derm.” Given the descriptive nature of “derm,” emphasis must be placed on the first four letters of each mark. It is evident that “Tero” and “Tega” are not similar in sight, sound or commercial impression and thus not confusingly similar.

11. Applicant denies that its goods are closely related to goods marketed and sold by Opposer under its TEGADERM mark. Applicant is informed and believes that Opposer sells transparent adhesive bandages under its TEGADERM mark. Opposer’s registrations for the TEGADERM mark lists “Transparent medical dressings” in International Class 5 (Reg. No. 1256605) and “Medical and surgical dressings, medical and surgical dressings containing antimicrobials; and wound fillers in the form of hydrogels” in International Class 5 (Reg. No. 3557085). Applicant sells excipients for the use in the compounding of pharmaceuticals under its Mark. Further, in discussing an amicable resolution to the Notice of Opposition, Applicant has offered to amend the Mark’s application to limit the description of goods including the removal of “materials for dressings” from the description of goods in International Class 5. Despite not being able to reach a resolution prior to Opposer filing its Opposition, Applicant is still willing to amend its application in order to remove any similar goods marketed and sold by Opposer under its TEGADERM mark. Applicant will seek to file a motion with the Trademark Trial and Appeal Board (the “Board”) amending the Mark’s application to revise the description of goods in International Class 5 as follows: “Pharmaceutical preparations; compounding agent used as a base in preparations of pharmaceuticals.” With the Board’s approval, such an amendment will result in no similarity or

relation between the goods marketed and sold by Opposer under its TEGADERM mark and Applicant's Mark.

12. Applicant denies that its goods are or will be marketed and sold in the same channels of commerce. Opposer's mark is used on goods that are sold directly to the public. Applicant's Mark is used in connection with goods sold exclusively to pharmacists and pharmaceutical compounding companies.

13. Applicant denies the similarities in the parties' marks, goods or trade channels. For the reasons set forth in the preceding paragraphs, Applicant denies that there is any likelihood of confusion in the marketplace or damage to Opposer. 14. Applicant denies that its mark is likely to dilute the distinctiveness of Opposer's mark for the reasons set forth herein.

15. Applicant denies that registration of its Mark will damage Opposer for the reasons set forth herein.

WHEREFORE, Applicant requests that Opposer's opposition be overruled and the registration sought by Applicant be accepted.

Please direct all correspondence to:

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[Continued on next page.]

Applicant herein appoints Stephen M. Doniger and all other attorneys of the firm Doniger / Burroughs APC to transact all business in the U.S. Patent and Trademark Office relating to this matter with full power of substitution.

Respectfully submitted,

ALEXSO, INC.

By its Attorneys

DONIGER / BURROUGHS

Dated: February 17, 2015

By:




Stephen M. Doniger, Esq.
Matthew DiNicola, Esq.
Attorneys for Plaintiff

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing
Applicant's Answer to Notice of Opposition has been served on
Opposer/Plaintiff's attorneys by mailing said copy on February 17, 2015, via
First Class Mail, postage prepaid to:

Scott W. Johnston
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Attorneys for Applicant,
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